

This Opinion is Not a  
Precedent of the TTAB

Mailed: February 14, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

—————  
Trademark Trial and Appeal Board

—————  
*In re Bioclinical Sciences, LLC*

—————  
Application Serial No. 90094476

Jason S. Smith of Hellman & Yates, PA, for Bioclinical Sciences, LLC.

Lance Cummins, Trademark Examining Attorney, Law Office 120,  
David Miller, Managing Attorney.

—————  
Before Cataldo, Shaw, and Dunn,  
Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

Bioclinical Sciences, LLC (Applicant) seeks registration on the Principal Register of the mark BIOCLINICAL SCIENCE (in standard characters) for “vitamin supplements,” in International Class 5.<sup>1</sup>

---

<sup>1</sup> Application Serial No. 90094476 was filed August 5, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as May 29, 2020.

The Trademark Status and Document Retrieval (TSDR) citations refer to the downloadable .pdf version of the documents available from the electronic file database for the involved application. The TTABVUE citations refer to the Board’s electronic docket, with the first number referring to the docket entry and the second, if applicable, the page within the entry.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the goods identified in the application, so resembles the mark BIOCLINIC NATURALS (NATURALS disclaimed), registered on the Principal Register for "dietary and nutritional supplements; dietary food supplements; food supplements; health food supplements; herbal supplements; nutraceuticals for use as a dietary supplement; vitamin and mineral supplements; all of the foregoing derived primarily from natural ingredients," in International Class 5<sup>2</sup> as to be likely to cause confusion, to cause mistake, or to deceive. The Trademark Examining Attorney also refused registration on the ground that the wording SCIENCE is merely descriptive of the identified goods and the mark is unregistrable absent a disclaimer of this term under Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a).

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register on both grounds.

### **I. Preliminary Matter**

The Examining Attorney initially informed Applicant that there were no conflicting registrations, and required a disclaimer of the term SCIENCE. Eight months later, with his apology, the Examining Attorney issued the Section 2(d) refusal based on the foregoing registration. Applicant dedicates part of both its appeal

---

<sup>2</sup> Registration No. 4647564 issued December 2, 2014, Sec. 8 filing accepted.

and reply briefs to arguing that the refusal must be reversed because the disclaimer was required as a strategy to support the refusal which would issue later, and because the delay in issuance of the refusal was unfair to Applicant.<sup>3</sup>

The disclaimer was withdrawn at Applicant's request. However, the absence of a disclaimer is not determinative when considering the distinctiveness of a term in a registered mark. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (“[T]he record evidence shows that, regardless of whether ‘Co.’ and ‘Club’ were disclaimed, they do not serve source-identifying functions). In addition, a disclaimer does not remove the disclaimed portion from the mark for the purposes of comparing marks in a likelihood of confusion determination. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). We reject Applicant's allegations that there was duplicity in the Examining Attorney's actions.

While it is true, as Applicant points out, that the Office aspires to complete first actions in the examination of each trademark application, when human or automation error causes the Office to fall short of that goal, the remedy is an apology, not issuance of a registration which should be refused. In fact, the Office's responsibility to issue proper refusals continues until the registration issues. *See TRADEMARK MANUAL OF EXAMINING PROCEDURE § 706.01 (July 2022)* (“[T]here is no restriction in the Trademark Act or Trademark Rules of Practice as to the period of time prior to registration when the USPTO may issue a new requirement or new

---

<sup>3</sup> 6 TTABVUE 7-8, 9 TTABVUE 2.

refusal. Moreover, an applicant may not directly challenge the Office’s determination under the clear-error standard that a new requirement or refusal must issue.”). Accordingly, this decision considers only the substantive refusal of registration.

## **II. Requirement for Disclaimer**

Section 6(a) of the Trademark Act provides that “[t]he Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” Under the terms of the statute, an Examining Attorney may require the disclaimer of unregistrable components, such as descriptive or generic terms. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013). The disclaimer disavows any exclusive right to use the specified word outside of its use within a composite mark. *Id.* (citing *In re Franklin Press, Inc.*, 597 F.2d 270, 201 USPQ 662, 665 (CCPA 1979)). Failure to comply with a disclaimer requirement is a ground for refusing registration. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005).

Merely descriptive terms are unregistrable under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), and are therefore subject to disclaimer if the mark otherwise is registrable. *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987); *In re RiseSmart, Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012). A term is merely descriptive if it immediately conveys knowledge of an ingredient, quality, or characteristic of the goods or services with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1954 (TTAB 2006). As noted in *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ

215 (CCPA 1978), the major reasons for requiring a disclaimer of descriptive terms are:

- (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and
- (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

*Id.* at 217. See also *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1085 (TTAB 2010) (“Highly descriptive terms... are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms.”) *quoted in Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1767 (TTAB 2013), *aff’d*, 565 Fed. Appx. 900 (Fed. Cir. 2014).

Evidence that a term is merely descriptive to the relevant purchasing public may be obtained from any competent source. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Dictionaries, newspapers, or surveys may provide evidence of mere descriptiveness. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1300 (Fed. Cir. 2012); *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). In addition, sources may include websites, publications, and use “in labels, packages, or in advertising material directed to the goods.” *In re N.C. Lottery*, 123 USPQ2d at 1710; *In re Abcor Dev. Corp.*, 200 USPQ at 218.

Here, the Examining Attorney required Applicant to disclaim the word SCIENCE in the mark because the word SCIENCE is commonly used in the supplements

industry to describe vitamin supplements which have been derived through scientific research.<sup>4</sup> The term SCIENCE is defined as “knowledge or a system of knowledge covering general truths or the operation of general laws especially as obtained and tested through scientific method” and “a system or method reconciling practical ends with scientific laws.”<sup>5</sup> The record includes examples of third-party use of the term SCIENCE, or the adjective form SCIENTIFIC, for supplements, describing vitamin supplements formulated through science to produce specific results (excerpted examples, **emphasis** added):



*Figure 1 Third party Approved Science supplement bottle*

APPROVED SCIENCE® is an established institute dedicated to improving individual health and well-being. Our team of medical experts will provide the latest **scientific** research, health information and guidance on our supplements to bring you to the forefront of medical advances. All our supplements are produced by a top-quality, cGMP certified and FDA licensed laboratory environment under the most rigorously professional conditions.

Approved Science webpage<sup>6</sup>

---

<sup>4</sup> 8 TTABVUE 14.

<sup>5</sup> November 30, 2020 Office Action TSDR 5, citing *Merriam Webster Online Dictionary*.

<sup>6</sup> November 30, 2020 Office Action TSDR 15-18.



*Figure 2 Third party Real Science supplement bottle*

My goal was to identify every single thing wrong with nearly all of the current “muscle building” and “fat burning” supplements on the market today, and to formulate a product line that directly addressed and overcame all of these issues. ... An approach based on true **science**, real research, and intelligent product formulation ... Every single ingredient used in our formulas is fully supported by legitimate peer-reviewed **scientific** literature and has been thoroughly assessed for safety and effectiveness. ... Each of our product pages includes a detailed breakdown of every ingredient used, along with the specific benefits and **scientific** studies supporting each one.

RealScience Athletics webpage<sup>7</sup>



*Figure 3 JYM Supplement Science bottle*

Founded in 2013 by renowned sports nutrition and supplement expert Jim Stoppani, PhD, the JYM brand is based on real **science**, the highest quality ingredients and, above all else, full transparency. JYM transformed the supplement industry by educating consumers on questionable marketing and manufacturing tactics like protein spiking, proprietary blends, and

---

<sup>7</sup> November 30, 2020 Office Action TSDR 6-13.

‘concentrated’ formulas. His personal and company mission is to change lives through proper training, nutrition and supplementation, all based on the latest **scientific** research, while following the motto of “Do the Right Thing.”  
JYM Supplement Science webpage<sup>8</sup>

In addition, the record includes copies of nine third-party registrations for “vitamin supplements” in which SCIENCE has been disclaimed (Registration Nos. 4720917 AMP SCIENCE, 5242311 FUNDAMENTAL SOUND SCIENCE, 5537832 ATP SCIENCE, 5630347 CORE MED SCIENCE, 5634333 ADVANCED LIFE SCIENCE, 6078820 RYSS VITAL SCIENCE, 6078821 V RYSS VITAL SCIENCE, 6186479 SCIENCE PRO NUTRITION, and 6438776 BONE SCIENCE).<sup>9</sup>

In traversing the Examining Attorney’s requirement for the disclaimer of the term SCIENCE, Applicant contends that the term is suggestive because “virtually all goods in the modern world” are created using science, and two of competitors quoted above as touting the science behind their supplements in fact have registrations for the marks APPROVED SCIENCE and JYM SUPPLEMENT SCIENCE for supplements in which SCIENCE is not disclaimed.<sup>10</sup>

We acknowledge the register is not a paragon of consistency with respect to disclaimers, and do not suggest that treatment of a term in third party registrations,

---

<sup>8</sup> November 30, 2020 Office Action TSDR 14.

<sup>9</sup> September 8, 2021 Office Action TSDR 21-45.

<sup>10</sup> 6 TTABVUE 11; March 7, 2022 Request for Reconsideration TSDR 309-318. Applicant also contends that “[t]he integration of the word SCIENCE in the composite mark BIOCLINICAL SCIENCE makes it obvious that no claim is being made to the word SCIENCE apart from the composite.” 6 TTABVUE 10. Applicant offers no explanation why the term BIOCLINICAL SCIENCE in a standard character mark would be considered “integrated,” and we disagree that it would be so considered.

alone, could support the disclaimer requirement. However, third party registrations are not the only evidence here, and we do accord the multiple registrations for supplements that include the SCIENCE disclaimer some probative value as to consumer perception of the term SCIENCE when used in marks for vitamin supplements. More compelling, we think, are the competitor's advertisements which tout the supplement formulations based on science. In addition, we note the record evidence from the National Institute of Health on the importance of science in assessing the effect on health by dietary supplements, including vitamin supplements (**emphasis added**):

What is a dietary supplement?

Dietary supplements are substances you might use to add nutrients to your diet or to lower your risk of health problems such as osteoporosis or arthritis. Dietary supplements come in the form of pills, capsules, powders, gel capsules and tablets, extracts, or liquids. They might contain **vitamins**, minerals, fiber, amino acids, herbs or other plants, or enzymes.

...

Learn. Find out as much as you can about any dietary supplement you might take. Talk with your doctor, pharmacist, or a registered dietitian. A supplement that seemed to help your neighbor might not work for you. If you are reading fact sheets or checking websites, be aware of the source of the information. Could the writer or group profit from the sale of a particular supplement? Read more about choosing reliable health information websites. Remember. Just because something is said to be "natural" doesn't mean it is safe or good for you. It could have side effects. It might make a medicine your doctor prescribed for you either weaker or stronger. It could also be harmful to you if you have certain medical conditions.

...

Check the **science**. Make sure any claim about a dietary supplement is based on scientific proof. Look for the United States Pharmacopeia (USP) verified mark. USP verifies the identity, quality, strength, and purity of supplements.

...

Dietary Supplements for Older Adults, NIH National Institute on Aging, Health Information<sup>11</sup>

---

<sup>11</sup> May 7, 2021 Office Action TSDR 17-18.

As noted above, the determination of the descriptiveness of a term in or comprising a mark is assessed in connection with the goods or services with which it is used. *See In re Gyulay*, 3 USPQ2d at 1217. While we do not disagree generally with Applicant's argument that science is the basis for many products, the record shows that the composition of the vitamin supplements at issue here are not subject to government regulation, and so are not required to be based on science.<sup>12</sup> Because the public is advised for health reasons to ensure for themselves that supplement formulations are based on science, we find that the record as a whole demonstrates that the term SCIENCE will be perceived as immediately conveying that Applicant's vitamin supplements are based on scientific formulations.

In sum, we find that SCIENCE merely describes a feature of Applicant's vitamin supplements, and must be disclaimed.

### **III. Likelihood of Confusion**

Our determination under Trademark Act Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (enumerating thirteen factors to be considered when testing for likelihood of confusion). "Whether a likelihood of confusion exists between an applicant's mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors." *Omaha*

---

<sup>12</sup> May 7, 2021 Office Action TSDR 22.

*Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018).

**1. Similarity or Dissimilarity of the Parties' Goods, Trade Channels, and Sales Conditions**

The second, third, and fourth *DuPont* factors assess the similarity or dissimilarity of the parties' goods, trade channels, and "the conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567. We must make our determination under these factors based on the goods as they are identified in the application and cited registration. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017). In assessing the similarity or dissimilarity and nature of the goods, the Board "considers whether 'the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the[ir] source or origin ....'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)).

Applicant seeks registration for "vitamin supplements" and the prior registration is for "dietary and nutritional supplements; dietary food supplements; food supplements; health food supplements; herbal supplements; nutraceuticals for use as a dietary supplement; vitamin and mineral supplements; all of the foregoing derived primarily from natural ingredients."

If an application or registration describes goods broadly, and there is no limitation as to their nature, it is presumed that the application or registration encompasses all

goods of the type described. *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”). Because Applicant’s vitamin supplements are not limited to particular ingredients, we presume that they encompass all ingredients, including the vitamin and mineral supplements “derived primarily from natural ingredients” listed in the pleaded registration. Moreover, based on the NIH explanation of dietary supplements quoted above, we presume the registered “dietary and nutritional supplements derived primarily from natural ingredients” include Applicant’s vitamin supplements. In sum, the goods are identical in more than one respect. No more is necessary to demonstrate a finding of similarity that supports a likelihood of confusion. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion).

Corroborating our presumptions regarding the relationship between the goods of Applicant and Registrant, the record also includes excerpts from five third party websites (Floradix, Equi.life, Ka’Chava, Wedderspoon, Naturally Vitamins) showing a single source for the vitamin supplements offered by both Applicant and Registrant, and the other types of supplements offered by Registrant.<sup>13</sup> In short, Applicant’s goods are at least in part identical to Registrant’s goods.

---

<sup>13</sup> September 8, 2021 Office Action TSDR 8-20.

Where, as here, the goods of the application at issue and the cited registration are in part identical, we must presume that the channels of trade and classes of purchasers for these goods are the same.<sup>14</sup> See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Info. Builders Inc.*, 2020 USPQ2d 228, at \*3 (TTAB 2021).

Applicant's reply brief states that Applicant does not dispute the close relationship between the goods.<sup>15</sup>

We find the *DuPont* factors regarding the similarities between the goods, channels of trade and conditions of sale strongly weigh in favor of finding a likelihood of confusion.

## **2. Similarity or Dissimilarity of the Parties' Marks**

We consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. See *Cai v. Diamond Hong*, 127 USPQ2d at 1800. The test under the first *DuPont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach*

---

<sup>14</sup> In its reply brief, Applicant states that the "relevant sophisticated consumer" was ignored by the Examining Attorney. 9 TTABVUE 3. Because Applicant submitted no evidence on this point, we disagree that it was ignored.

<sup>15</sup> 6 TTABVUE 10.

*Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

Because the identified goods are identical in part, a lesser degree of similarity between the marks is required for confusion to be likely. *See Bridgestone Americas Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 1337, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012) (“When the goods are identical, the appearance of a mark of similar sound, appearance, or connotation is more likely to cause confusion than if the goods are significantly different.”); *Century 21 Real Estate v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir.1992) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”).

When comparing Applicant’s mark BIOCLINICAL SCIENCE to the registered mark BIOCLINIC NATURALS, we find almost the identical coined term followed by terms that describe important qualities of the supplements, namely whether they are based on scientific formulations or include natural ingredients. As a result, we find the beginning coined terms BIOCLINICAL and BIOCLINIC are dominant in each mark and highly similar in all respects. That is, because they are identical as to the eight letters and four syllables which form most of Applicant’s mark BIOCLINICAL and all of the registered mark BIOCLINIC, they look the same and sound the same. We find that the addition of the letters-AL, while making Applicant’s mark slightly longer and adding a syllable to its pronunciation, does little to distinguish the marks as to sight and sound.

As to connotation, the record shows BIO is a prefix that means “connected with life and living things;” CLINIC is a noun that means “a building, often part of a hospital, to which people can go for medical care or advice relating to a particular condition;” and CLINICAL is an adjective defined as “used to refer to medical work or teaching that relates to the examination and treatment of ill people.”<sup>16</sup> The term -AL is defined as a suffix “of the kind of, pertaining to, having the form or character of” that named by the stem.<sup>17</sup> Based on both the definitions for CLINIC and CLINICAL, and Applicant’s addition of the letters -AL to the term BIOCLINIC in the registered mark to make an adjective out of a noun, the differences in the terms create no difference in the connotations. *See In re Dalquist, Inc.*, 192 USPQ 237, 238 (TTAB 1976) (“The past tense, ‘phased’, of the verb of which ‘phase’ is the present tense and ‘phasing’ is the present participle, would, we think, convey to purchasers of, and dealers in, high fidelity sound reproduction equipment the same meaning or connotation as the words ‘phase’ and ‘phasing.’”).

We find that the coined terms BIOCLINICAL and BIOCLINIC when applied to the identical vitamin supplements share the same connotation of a means of wellness to improve living, and so are suggestive but nonetheless inherently distinctive marks which are accorded an ordinary scope of protection on the spectrum of marks.<sup>18</sup> In

---

<sup>16</sup> March 7, 2022 Request for Reconsideration TSDR 319-21, citing Cambridge Dictionary, available at <https://dictionary.cambridge.org/us/dictionaiy/english/>.

<sup>17</sup> May 7, 2021 Office Action TSDR 8-15 (Dictionary.com).

<sup>18</sup> The fifth *DuPont* factor is the “fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567. The fame of the registered mark does not automatically arise in an ex parte proceeding, and no evidence on this factor has been offered here. *See In re i.am.symbolic, LLC*, 116 USPQ2d 1406, 1413 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123 USPQ2d

addition, BIOCLINIC NATURALS is registered on the Principal Register without a showing of acquired distinctiveness, and is presumed to be inherently distinctive under Section 7(b) of the Trademark Act.

Looking at the marks BIOCLINICAL SCIENCE and BIOCLINIC NATURALS as a whole, the facts that the terms SCIENCE and NATURALS do not look or sound alike and have different meanings do not outweigh the fact that they serve the related function in their respective marks of describing important characteristics of the supplements. The term NATURALS is disclaimed in the registered mark, an admission of descriptiveness, and as discussed, we find that SCIENCE also is descriptive as applied to vitamin supplements. *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1442 (TTAB 2005) (“[I]t has long been held that the disclaimer of a term constitutes an admission of the merely descriptive nature of that term ... at the time of the disclaimer”). Disclaimed or descriptive terms are considered less significant features of the mark. *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). For this reason, we consider SCIENCE and NATURALS to create similar impressions and to contribute strongly to the similarity of the commercial impression of the marks BIOCLINICAL SCIENCE and BIOCLINIC NATURALS. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372-73, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (affirming TTAB’s holding that contemporaneous use of appellant’s mark, VEUVE ROYALE, for sparkling wine,

---

1744 (Fed. Cir. 2017) (“Because of the nature of the evidence required to establish the fame of a registered mark, the Board normally does not expect the Examining Attorney to submit evidence as to the fame of the cited mark in an ex parte proceeding.”).

and appellee's marks, VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN, for champagne, is likely to cause confusion, noting that the presence of the "strong distinctive term [VEUVE] as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE").

Applicant contends "the components BIO and CLINIC or CLINICAL are frequently used, well recognized, weak terms that are not overly dominant in the respective composite marks, despite appearing first-in-order."<sup>19</sup> In addition to the definitions, Applicant relies on TESS (Trademark Electronic Search System) pages showing the results of the search for each component term in the USPTO basic index, with BIO appearing 34,183 times, and CLINIC appearing 7,066 times.<sup>20</sup> In support, Applicant cites the principle that evidence of extensive third-party use of a term, on the same or similar goods in the relevant marketplace, is probative of the term's weakness as a trademark. *See In re Medline Indus., Inc.*, 2020 USPQ2d 10237, \*11 n. 38 (TTAB 2020); *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565-66 (TTAB 1996).

The principle has no application here. There is no evidence that the component terms BIO or CLINIC are used on their own as marks, much less the terms used together, and because the TESS search was not restricted to supplements, even if the search results showed use of the component terms as marks, it would not show use

---

<sup>19</sup> 6 TTABVUE 9 n.2.

<sup>20</sup> March 7, 2022 Request for Reconsideration TSDR 322-324.

on the same or similar goods. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 128 USPQ2d at 1694 (“[T]he present analysis [of whether third party use affects the mark’s scope of protection] only involves goods like those being offered by the parties to the ‘relevant public,’ while third-party use outside of that relevant market is meaningless.”); *In re i.am.symbolic, llc*, 123 USPQ2d at 1751 (“Symbolic has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes, e.g., its class 25 registration for clothing, support a finding that registrants’ marks are weak with respect to the goods identified in their registrations.”). We disagree that the record supports any restriction of the scope of protection accorded the registered mark BIOCLINIC NATURALS. Rather, as noted above, the terms BIOCLINIC and BIOCLINICAL are at least suggestive.

Applicant also contends that its mark should be allowed to register because the cited mark was allowed to register over a third-party registered mark for nutritional supplements, now cancelled, for the term BIOCLIN (cancelled Registration No. 2972833).<sup>21</sup> If two confusingly similar marks for the same goods co-exist on the register, the fact does not support registration of a third confusingly similar mark for the same goods. *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) (“Even if all of the third-party registrations should have been refused registration under section 1052(a), such errors do not bind the USPTO to

---

<sup>21</sup> 6 TTABVUE 8; March 7, 2022 Request for Reconsideration TSDR 25-220 (application file for cited registration).

improperly register Applicant's marks.") (citation omitted); *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) ("The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases.").

As was pointed out to Applicant, the record includes the consent of the first registrant to registration of the mark now cited against Applicant.<sup>22</sup> In such circumstances, the Board is urged not to substitute its own judgment for those of the involved parties. "[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not." *DuPont*, 177 USPQ at 568. There is no such uncontroverted evidence here to outweigh the evidence that marks sharing variations of the same arbitrary coined term with a descriptive term are used on identical goods.

In short, we have carefully considered but remain unconvinced by Applicant's arguments why the differences between the marks BIOCLINICAL SCIENCE and BIOCLINIC NATURALS are not likely to cause confusion when used on the same vitamin supplements, as well as related supplements.

---

<sup>22</sup> March 7, 2022 Request for Reconsideration TSDR 49-50.

#### **IV. Decision**

The refusals to register Applicant's mark BIOCLINICAL SCIENCE in the absence of a disclaimer of the term SCIENCE and for likelihood of confusion with the cited mark are affirmed.